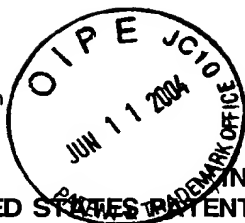


AGILENT TECHNOLOGIES, INC.
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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

ATTORNEY DOCKET NO. 10010106-1

Inventor(s): Jeffrey Davis et al.

Serial No.: 09/812,754

Examiner: Motilewa Good Johnson

Filing Date: March 20, 2001

Group Art Unit: 2672

Title: SCROLLING METHOD USING SCREEN POINTING DEVICE

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Technology Center 2600

ASSISTANT COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 8, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

| | |
|------------------|-----------|
| () one month | \$110.00 |
| () two months | \$420.00 |
| () three months | \$950.00 |
| () four months | \$1480.00 |

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 50-1078 the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25.

(X) A duplicate copy of this transmittal letter is enclosed. ✓

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 222313-1450.
Date of Deposit: June 7, 2004 or

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

() Date of Facsimile:

Typed Name: Jeff A. Holmen

Signature: Jeff A. Holmen

Respectfully submitted,

Jeffrey Davis et al.

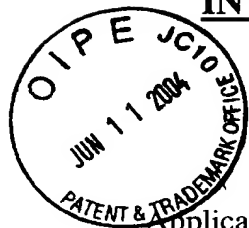
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

| | | | |
|------------------|---|-----------------|---------------------------|
| Applicant: | Jeffrey Davis et al. | Examiner: | Motilewa Good Johnson |
| Serial No.: | 09/812,754 | Group Art Unit: | 2672 |
| Filed: | March 20, 2001 | Docket No.: | 10010106-1 (A310.106.101) |
| Due Date: | June 8, 2004 | | |
| Title: | SCROLLING METHOD USING SCREEN POINTING DEVICE | | |

APPEAL BRIEF TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Dear Sir or Madam:

APPELLANTS' BRIEF ON APPEAL

This Brief is presented in support of the Notice of Appeal filed on April 8, 2004, from the Final Office Action mailed January 12, 2004 and the subsequent Advisory Action dated April 5, 2004 formally rejecting claims 1-4 and 6-24 of the above-identified application. Twenty-three claims remain for consideration.

The Appeal Brief is filed in triplicate. The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 50-1078 in the amount of \$330.00 for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. 1.17(c), however, at any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account No. 50-1078 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account No. 50-1078 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21. Appellants respectfully request reversal of the Examiner's rejection of pending claims 1-4 and 6-24.

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REAL PARTY IN INTEREST

The present application has been assigned to Agilent Technologies, Inc., a Delaware corporation, doing business at 395 Page Mill Road, Palo Alto, California 94306.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, which will have a bearing on the Board's decision in the present appeal.

STATUS OF THE CLAIMS

Claims 1-4 and 6-24 are pending in the application. (See Appendix A). Claims 1-4 and 6-24 were rejected and the rejection made final in the Office Action dated January 12, 2004, and the subsequent Advisory Action mailed April 5, 2004, and are the subject of the present Appeal.

In the final Office Action, the Examiner rejected claims 1, 2, 6-20, 23, and 24 under 35 U.S.C. §102(b) as being anticipated by Tiphane, U.S. Patent No. 5,805,161 ("Tiphane"). Claims 3, 4, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tiphane as applied to claims 1 and 19, and further in view of Ishikawa, U.S. Patent No. 5,506,951 ("Ishikawa").

Claim 5 has been cancelled. Claims 1-4 and 6-24 are appealed herein.

STATUS OF AMENDMENTS

As understood by the Appellants, no amendments to the claims have been entered subsequent to the final Office Action mailed January 12, 2004. The claims listed in Appendix A reflect the claims as of January 12, 2004. A Response After Final was filed on March 11, 2004, but no amendments to the claims were proposed by Appellants, or entered by the Examiner.

SUMMARY OF THE INVENTION

The present invention, as claimed in independent claim 1, provides a method of scrolling through information displayed on a display screen of an electronic device. The display screen includes a screen pointer controllable by a user with a screen pointing device.

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The method includes providing a first plurality of user selectable scrolling zones on the display screen, each scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a first direction, each of the scrolling zones in the first plurality being positioned substantially adjacent to a first edge of the display screen. The method includes providing a second plurality of user selectable scrolling zones on the display screen, each scrolling zone in the second plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a second direction that is different from the first direction, each of the scrolling zones in the second plurality of being positioned substantially adjacent to a second edge of the display screen, wherein the first edge is opposite to the second edge. The method includes receiving zone selection information identifying a first one of the scrolling zones selected by a user with the screen pointing device. The method includes scrolling through the displayed information based on the scrolling technique associated with the selected scrolling zone. (See, e.g., specification at page 6, line 4 to page 9, line 13; Figures 2A and 2B, reference numbers 200, 202A – 202B, 204A – 204D, 206, 220, 222A – 222D, and 224A – 224D).

In another embodiment, the present invention, as claimed in independent claim 19, provides an electronic device including a display screen for displaying information. The display screen includes a screen pointer controllable by a user with a screen pointing device. The display screen includes a first plurality of user selectable scrolling zones, each user selectable scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and having a user selectable area defined by hidden boundaries. The electronic device includes a controller for receiving zone selection information identifying a first one of the scrolling zones selected by a user with the screen pointing device. The controller is configured to cause information displayed on the display screen to scroll based on the scrolling technique associated with the selected scrolling zone. (See, e.g., specification at page 4, line 13 to page 8, line 3; Figures 1 and 2A, reference numbers 10, 12, 16, 24, 30, 200, 202A – 202D, 204A – 204D, and 206).

In another embodiment, the present invention, as claimed in independent claim 23, provides a method of scrolling through information displayed on a display screen of an electronic device. The display screen includes a screen pointer controllable by a user with a screen pointing device. The method includes receiving mode selection information from a

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user. The mode selection information indicates that a user has selected a scroll mode. The method includes receiving movement information provided by a user with the screen pointing device. The method includes determining a first movement direction and a first movement velocity based on the received movement information. The method includes moving the screen pointer based on the received movement information. The method includes scrolling the displayed information on the display screen in a direction corresponding to the first movement direction and in an amount based on the first movement velocity. The scrolling amount is greater than the amount of movement of the screen pointer. (See, e.g., specification at page 13, line 4 to page 14, line 21; Figure 4, reference numbers 400 – 414).

ISSUES PRESENTED FOR REVIEW

I. Whether the rejection of claims 1, 2, 6-20, 23, and 24 in the Final Office Action mailed January 12, 2004, under 35 U.S.C. §102(b) as being anticipated by Tiphane, U.S. Patent No. 5,805,161 (“Tiphane”) is valid.

II. Whether the rejection of claims 3, 4, 21, and 22 in the Final Office Action mailed January 12, 2004, under 35 U.S.C. §103(a) as being unpatentable over Tiphane in view of Ishikawa, U.S. Patent No. 5,506,951 (“Ishikawa”) sets forth a case of *prima facie* obviousness.

GROUPING OF THE CLAIMS

The claims do not stand or fall together, but are grouped as follows and each group is believed to be separately patentable.

- I. Claims 1, 9-11, 13, 14, 16, 17, 18, and 24.
- II. Claim 2.
- III. Claim 3.
- IV. Claim 4.
- V. Claims 6 and 7.
- VI. Claim 8.
- VII. Claim 12.
- VIII. Claims 15.
- IX. Claim 19.

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X. Claim 20.

XI. Claim 21.

XII. Claim 22.

XIII. Claim 23.

ARGUMENT

I. Rejections Under 35 U.S.C. §102

A. The Applicable Law

“A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single, prior art reference.” *Verdegaal Bros. v. Union Oil Co., of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

B. Rejection of Claims 1, 2, 6-20, 23, and 24 based on Tiphane

The rejection of claims 1, 2, 6-20, 23, and 24 in the Final Office Action mailed January 12, 2004, under 35 U.S.C. §102(b) as being anticipated by Tiphane, U.S. Patent No. 5,805,161 (“Tiphane”) is not correct and should be withdrawn.

Independent claim 1 includes the limitations:

providing a first plurality of user selectable scrolling zones on the display screen, each scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a first direction, each of the scrolling zones in the first plurality being positioned substantially adjacent to a first edge of the display screen;

providing a second plurality of user selectable scrolling zones on the display screen, each scrolling zone in the second plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a second direction that is different from the first direction, each of the scrolling zones in the second plurality being positioned substantially adjacent to a second edge of the display screen, wherein the first edge is opposite to the second edge;

Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned

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on opposite edges of a screen as recited in claim 1. Rather, Tiphane discloses a horizontal scroll box 450 and a vertical scroll box 440. (See, e.g., Tiphane at Figures 4A, 4B, and 5, and corresponding description). These scroll bars are not positioned on opposite edges of a display screen, and these scroll bars do not each include a plurality of scrolling zones as defined in claim 1.

Tiphane also discloses a pop-up box menu 420. (Tiphane at Figures 4A, 4B, and 5). Tiphane discloses that “[t]he pop-up box menu has nine buttons representing particular functions including a button for vertical scrolling 425 and a button for horizontal scrolling 430.” (Tiphane at col. 5, lines 6-9). Tiphane does not define what the functions are of the other seven buttons in the pop-up box menu. There is no teaching or suggestion in Tiphane that the other seven buttons in the pop-up box menu are related to scrolling functions. Tiphane’s disclosure regarding the pop-up box menu with a single button for vertical scrolling 425 and a single button for horizontal scrolling 430 does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen as recited in claim 1.

In the Final Office Action, the Examiner stated that:

Applicant argues that Tiphane fails to disclose a first and second plurality of scrolling zones each corresponding to scrolling in different directions and position on opposite edges of a screen. Tiphane discloses a box menu on the screen in which a computer application may be scrolled depending on the scroll direction chosen. Applicant argues that the scroll bars are no position on opposite edges of a display screen. It is **inherent** that the scroll zones disclosed in Tiphane may be positioned in any zone area as a **design modification**.

Applicant argues that Tiphane fails to teach or suggest a first and a second plurality of scrolling zone corresponding to scrolling in different directions. Tiphane discloses nine boxes uses for representing particular functions, col. 5, lines 1-15. Tiphane discloses allowing a user to perform a desired scrolling function. Therefore, it is **inherent** that the seven other buttons **may be used** to provide additional scrolling functions. (Final Office Action at para. no. 10, pages 8-9) (emphasis added).

Appellant respectfully disagrees with the Examiner’s statements that “[i]t is inherent that the scroll zones disclosed in Tiphane may be positioned in any zone area as a design modification” and “it is inherent that the seven other buttons may be used to provide additional scrolling functions.” As the Federal Circuit has stated, “[i]nherent anticipation

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requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., v. Top-U.S.A. Corp.*, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). The Examiner appears to acknowledge that the claim limitations are not “necessarily present” in Tiphane by indicating that a “design modification” to Tiphane is needed, and that the seven other buttons “may be” used to provide additional scrolling functions. Thus, Tiphane does not explicitly teach or suggest each and every limitation of claim 1, and the missing claim limitations are not “necessarily present” in Tiphane.

In view of the above, independent claim 1 is not taught or suggested by Tiphane. Appellants submit that independent claim 1 is not anticipated by Tiphane, and respectfully request that the rejection of independent claim 1 under 35 U.S.C. § 102(b) be withdrawn.

Dependent claims 2, 6-18, and 24, which further limit patentably distinct claim 1, are also believed to be allowable over the cited reference. In addition, claims 2, 6-18, and 24 are further distinguishable over the cited prior art. Dependent claims 2, 6-8, 12, and 15, are addressed below.

Claim 2 is dependent on independent claim 1, and recites “wherein each scrolling technique corresponds to a scrolling speed.” With respect to claim 2, the Examiner stated in the Final Office Action that “Tiphane discloses a elevator bar which is moved to perform scrolling process movement by the user, therefore performing a scrolling speed, col. 6, lines 1-18”. (Final Office Action at para. no. 6, page 3). Claim 2 does not recite “performing a scrolling speed”. Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen, as recited in independent claim 1 and described above with respect to claim 1, nor does Tiphane teach or suggest that each of the scrolling zones in the first and the second pluralities is associated with a scrolling technique that corresponds to a scrolling speed, as recited in dependent claim 2.

Claim 6 is dependent on independent claim 1, and recites “wherein the first plurality of scrolling zones is positioned substantially adjacent to a top of the display screen and corresponds to upward scrolling, and wherein the second plurality of scrolling zones is positioned substantially adjacent to a bottom of the display screen and corresponds to downward scrolling.” With respect to claim 6, the Examiner stated in the Final Office Action

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that “Tiphane discloses a menu subsystem with a box menu, i.e. zones, which providing scrolling functions displayed on a screen, col. 4, lines 54-67”. (Final Office Action at para. no. 6, page 3). Claim 6 does not recite “providing scrolling functions displayed on a screen”. Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen, as recited in independent claim 1 and described above with respect to claim 1, nor does Tiphane teach or suggest that the first plurality of scrolling zones is positioned substantially adjacent to a top of the display screen and corresponds to upward scrolling, and that the second plurality of scrolling zones is positioned substantially adjacent to a bottom of the display screen and corresponds to downward scrolling, as recited in dependent claim 6.

Claim 7 is dependent on independent claim 1, and recites “wherein the first plurality of scrolling zones is positioned substantially adjacent to a left edge of the display screen and corresponds to leftward scrolling, and wherein the second plurality of scrolling zones is positioned substantially adjacent to a right edge of the display screen and corresponds to rightward scrolling.” With respect to claim 7, the Examiner stated in the Final Office Action that “Tiphane discloses in figures 4A and 4B”. (Final Office Action at para. no. 6, page 4). Figures 4A and 4B of Tiphane are addressed above with respect to claim 1, and do not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen, as recited in independent claim 1 and described above with respect to claim 1, nor does Tiphane teach or suggest that the first plurality of scrolling zones is positioned substantially adjacent to a left edge of the display screen and corresponds to leftward scrolling, and wherein the second plurality of scrolling zones is positioned substantially adjacent to a right edge of the display screen and corresponds to rightward scrolling, as recited in dependent claim 7.

Claim 8 is dependent on independent claim 1, and recites “providing a third and a fourth plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a third direction that is different from the first and the second directions, each scrolling zone in the fourth plurality of scrolling zones associated with a scrolling technique

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and corresponding to scrolling in a fourth direction that is different from the first, second, and third directions.” With respect to claim 8, the Examiner stated in the Final Office Action that “Tiphane discloses a process for jumping and locking onto an elevator bar of a scroll box when a system call for a scroll box is detected and the process determines a call has been detected and call the appropriate scroll box sub-process, col. 6, lines 50-64, therefore making it inherent that any of the boxes may be called in a subroutine to perform a scroll function”. (Final Office Action at para. no. 6, page 4). Claim 8 does not recite “boxes may be called in a subroutine to perform a scroll function.” Tiphane does not teach or suggest providing a third and a fourth plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a third direction that is different from the first and the second directions, each scrolling zone in the fourth plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a fourth direction that is different from the first, second, and third directions, as recited in dependent claim 8.

Claim 12 is dependent on independent claim 1, and recites “wherein the scrolling techniques associated with the scrolling zones are user definable”. With respect to claim 12, the Examiner stated in the Final Office Action that “Tiphane discloses the invention may be augmented by adding menu selections, col. 5, lines 35-37”. (Final Office Action at para. no. 6, page 5). The portion of Tiphane cited by the Examiner discloses that “The Windows 95 menu typically includes selections for launching applications, opening folders, or the like. The present invention may augment this menu by adding menu selections for the vertical scroll box 440 and the horizontal scroll box 450.” (Tiphane at col. 5, lines 33-37). Tiphane indicates that rather than using a pop-up box menu 420 with one button for vertical scrolling 425 and one button for horizontal scrolling 430, these two buttons could be incorporated into a standard Windows 95 menu as menu selections. (See, e.g., Tiphane at col. 5, lines 6-37). This disclosure that a standard Windows 95 menu may be augmented by adding menu selections does not teach or suggest “the scrolling techniques associated with scrolling zones are user definable” as recited in dependent claim 12.

Claim 15 is dependent on independent claim 1, and recites “providing a third plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to

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scrolling in a direction that is different from the first and the second directions, and wherein the first, the second, and the third plurality of user selectable scrolling zones collectively include nine scrolling zones organized into three columns and three rows.” With respect to claim 15, the Examiner stated in the Final Office Action that “Tiphane discloses in figures 4A and 4B”. (Final Office Action at para. no. 6, page 5). Figures 4A and 4B of Tiphane are addressed above with respect to claim 1, and do not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen, as recited in independent claim 1 and described above with respect to claim 1, nor does Tiphane teach or suggest providing a third plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a direction that is different from the first and the second directions, and wherein the first, the second, and the third plurality of user selectable scrolling zones collectively include nine scrolling zones organized into three columns and three rows, as recited in dependent claim 15.

In view of the above, dependent claims 2, 6-18, and 24 are not taught or suggested by Tiphane. Appellants submit that dependent claims 2, 6-18, and 24 are not anticipated by Tiphane, and respectfully request that the rejection of dependent claims 2, 6-18, and 24 under 35 U.S.C. § 102(b) be withdrawn.

Independent claim 19 includes the limitation “each user selectable scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and having a user selectable area defined by hidden boundaries”. With respect to independent claim 19, the Examiner stated in the Final Office Action that “[a]s per independent claim 19 and dependent claim 20, they are rejected based upon similar rational as above independent claim 1 and dependent claim 2.” (Final Office Action at page 6, para. no. 6). The Examiner’s statements in the Final Office Action regarding claim 1 and dependent claim 2 did not address hidden boundaries. However, the Examiner did state in the Final Office Action with respect to another claim that “[w]ith respect to dependent claim 24, wherein at least one of the scrolling zones is defined by hidden boundaries that are invisible to a user of the electronic device. (Tiphane discloses removing the pop-up box menu from the display screen of the display, col.

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5, lines 59-60, therefore making the scroll boxes invisible to a user).” (Office Action at para. no. 6, page 6).

In the Final Office Action, the Examiner also stated that:

Applicant argues that Tiphane fails to disclose “each user selectable scrolling zone associated with a scrolling technique and having a user selectable area defined by hidden boundaries”. Tiphane discloses that depressing the mouse calls up the pop-up box menu and upon selection of an item in the menu subsystem the pop-up box menu is removed from the display screen and the user moves the elevator bar of the selected scroll function to perform the desired scroll movement. **Tiphane does not disclose the boundaries of the zone or menu area are hidden**, however **it is inherent** that once selected the menu boundaries are not present on the screen and the user is able to further perform the selected scrolling technique. (Final Office Action at para. no. 10, page 9) (emphasis added).

The Examiner appears to acknowledge that Tiphane does not explicitly teach or suggest each and every limitation of claim 19 by stating the “Tiphane does not disclose the boundaries of the zone or menu area are hidden.” The Examiner is again apparently relying on the concept of inherent anticipation. However, to rely on inherent anticipation, user selectable scrolling zones having a user selectable area defined by hidden boundaries would have to be “necessarily present” in Tiphane. *Trintec Indus., v. Top-U.S.A. Corp.*, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Such scrolling zones are not necessarily present in Tiphane. To the contrary, the boundaries of buttons 425 and 430 in pop-up box menu 420, and the boundaries of the elevator bars 445 and 455, are clearly visible in Figures 4A, 4B, and 5, of Tiphane. If the pop-up box menu is removed from the display screen as suggested by the Examiner, the buttons 425 and 430 would be removed and would not be “user selectable” as recited in claim 19. Thus, the pop-up box menu 420 does not include a user selectable area defined by hidden boundaries when the menu 420 is displayed, nor does the pop-up box menu 420 include a user selectable area defined by hidden boundaries when the menu 420 is removed. Similarly, the elevator bar 445 or 455 relied on by the Examiner does not include a user selectable area defined by hidden boundaries. Automatically re-positioning a screen pointer 435 from a pop-up box menu with visible boundaries to an elevator bar 445 or 455 with visible boundaries, as disclosed in Tiphane, does not teach or suggest user selectable scrolling

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zones having a user selectable area defined by hidden boundaries as recited in independent claim 19.

In view of the above, independent claim 19 is not taught or suggested by Tiphane. Appellants submit that independent claim 19 is not anticipated by Tiphane, and respectfully request that the rejection of independent claim 19 under 35 U.S.C. § 102(b) be withdrawn.

Dependent claim 20, which further limits patentably distinct claim 19, is also believed to be allowable over the cited reference. In addition, dependent claim 20 is further distinguishable over the cited prior art. Dependent claim 20 recites “wherein each scrolling technique corresponds to a scrolling speed.” With respect to claim 20, the Examiner stated in the Final Office Action that “[a]s per independent claim 19 and dependent claim 20, they are rejected based upon similar rational as above independent claim 1 and dependent claim 2.” (Final Office Action at page 6, para. no. 6). With respect to claim 2, the Examiner stated in the Final Office Action that “Tiphane discloses a elevator bar which is moved to perform scrolling process movement by the user, therefore performing a scrolling speed, col. 6, lines 1-18”. (Final Office Action at para. no. 6, page 3). Claim 20 does not recite “performing a scrolling speed”. Tiphane does not teach or suggest that each of the scrolling zones in the first plurality is associated with a scrolling technique that corresponds to a scrolling speed, as recited in dependent claim 20.

In view of the above, dependent claim 20 is not taught or suggested by Tiphane. Appellants submit that dependent claim 20 is not anticipated by Tiphane, and respectfully request that the rejection of dependent claim 20 under 35 U.S.C. § 102(b) be withdrawn.

Independent claim 23 includes the limitations “determining . . . a first movement velocity . . .;” and “scrolling the displayed information on the display screen . . . in an amount based on the first movement velocity, the scrolling amount greater than the amount of movement of the screen pointer.” Applicant pointed out in the Response filed on October 20, 2003 that the Examiner did not appear to address these limitations in claim 23. In the Final Office Action, the Examiner replied as follows:

Applicant argues that the Examiner fails to address the limitation of determining a first movement velocity and scrolling the displayed amount in an amount based on the first movement velocity. The Examiner addresses this limitation as being disclosed in Tiphane as an elevator bar which performs the scroll function from the transmitted signal, col. 5, lines 55-58. (Final Office Action at para. no. 10, pages 9-10).

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Col. 5, lines 55-58, of Tiphane, which is relied on by the Examiner, comprises a portion of one sentence. That one sentence reads as follows: “The jump subsystem 310 repositions, or “jumps,” the pointer 435 from the vertical scroll box 440 and transmits a signal through the central processing unit 210 to the menu subsystem 320 in the memory 260 indicating that the menu subsystem 320 should remove the pop-up box menu 420 from the display screen of the display 120.” (Tiphane at col. 5, lines 53-60). This cited portion of Tiphane does not teach or suggest determining a velocity from movement information provided by a screen pointing device, nor scrolling an amount based on such velocity, nor that the scrolling amount is greater than the amount of movement of the screen pointer.

In view of the above, independent claim 23 is not taught or suggested by Tiphane. Appellants submit that independent claim 23 is not anticipated by Tiphane, and respectfully request that the rejection of independent claim 23 under 35 U.S.C. § 102(b) be withdrawn.

II. Rejections Under 35 U.S.C. §103

A. The Applicable Law

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). These three criteria are also set forth in §706.02(j) of the M.P.E.P.

Even when obviousness is based on a single reference, there must be a showing of suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). In performing the obviousness inquiry under 35 U.S.C. §103, the Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568

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(Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

B. Rejection of Claims 3, 4, 21, and 22 based on Tiphane and Ishikawa

The rejection of claims 3, 4, 21, and 22 in the Final Office Action mailed January 12, 2004, under 35 U.S.C. §103(a) as being unpatentable over Tiphane and Ishikawa, is not correct and should be withdrawn, because the rejection fails to establish a case of *prima facie* obviousness.

Claims 3 and 4 are dependent on independent claim 1. As described above with respect to claim 1, Tiphane does not teach or suggest a first and a second plurality of scrolling zones, each plurality corresponding to scrolling in different directions, and each plurality positioned on opposite edges of a screen as recited in claim 1. Ishikawa also does not teach or suggest these limitations of claim 1.

There is also no suggestion to combine Tiphane and Ishikawa. As the Federal Circuit has stated, “[i]n holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286, 1293 (CAFC 2001). The Examiner acknowledged in the Final Office Action that “Tiphane fails to disclose a scrolling granularity and a scrolling granularity including line scrolling, paragraph scrolling and page scrolling.” (Final Office Action at para. no. 8, page 7). However, the Examiner stated that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to include in the jump subsystem disclosed in Tiphane the line and page scrolling as disclosed in Ishikawa, **because Tiphane discloses augmenting the menu selection** and to add additional scroll techniques in the menu boxes would provide the user with a variety of selections for scroll techniques.” (Final Office Action at para. no. 8, page 7) (emphasis added).

Thus, the Examiner appears to contend that the statement in Tiphane regarding augmenting a menu somehow suggests combining Tiphane and Ishikawa in a manner that would produce the claimed invention. The statement in Tiphane regarding augmenting a menu reads as follows: “The Windows 95 menu typically includes selections for launching applications, opening folders, or the like. The present invention may augment this menu by

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adding menu selections for the vertical scroll box 440 and the horizontal scroll box 450.” (Tiphane at col. 5, lines 33-37). Thus, Tiphane indicates that, rather than using a pop-up box menu 420 with one button for vertical scrolling 425 and one button for horizontal scrolling 430, these two buttons could be incorporated into a standard Windows 95 menu as menu selections. (See, e.g., Tiphane at col. 5, lines 6-37). There is no teaching or suggestion in Tiphane “to add additional scroll techniques in the menu boxes” as indicated by the Examiner. There is no teaching or suggestion in Ishikawa to modify a box menu, or a standard Windows 95 menu, such as those disclosed in Tiphane, to produce the invention recited in dependent claims 3 and 4.

In view of the above, dependent claims 3 and 4 are not taught or suggested by Tiphane and Ishikawa, either alone or in combination. The Examiner has not established a case of *prima facie* obviousness of claims 3 and 4, and Appellants respectfully request that the rejection of claims 3 and 4 be withdrawn.

Claims 21 and 22 are dependent on independent claim 19. As described above with respect to claim 19, Tiphane does not teach or suggest user selectable scrolling zones having a user selectable area defined by hidden boundaries as recited in claim 19. Ishikawa also does not teach or suggest these limitations of claim 19. There is also no suggestion to combine Tiphane and Ishikawa, as described above with respect to claims 3 and 4.

In view of the above, dependent claims 21 and 22 are not taught or suggested by Tiphane and Ishikawa, either alone or in combination. The Examiner has not established a case of *prima facie* obviousness of claims 21 and 22, and Appellants respectfully request that the rejection of claims 21 and 22 be withdrawn.

CONCLUSION

For the above reasons, Appellants respectfully submit that the cited art neither anticipates nor renders the claimed invention obvious, and therefore the claimed invention does patentably distinguish over the cited art. Therefore, Appellants respectfully submit that the above rejections to pending claims 1-4 and 6-24 must be withdrawn and that these claims be allowed.

The U.S. Patent and Trademark Office is hereby authorized to charge the fee of \$330.00 to Deposit Account No. 50-1078 for filing an a Appeal Brief as set forth under 37

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C.F.R. 1.17(c). However, at any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 C.F.R. 1.25. Additionally, please charge any additional fees to Deposit Account 50-1078 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Any inquiry regarding this Amendment and Response should be directed to Jeff A. Holmen at the below-listed telephone number or Pamela Lau Kee at Telephone No. (408) 553-3059, Facsimile No. (408) 553-3063. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7th day of June, 2004.

By Jeff A. Holmen
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Appeal Brief – Appendix A

Applicant: Jeffery Davis

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IN THE CLAIMS

1.(Previously Presented) A method of scrolling through information displayed on a display screen of an electronic device, the display screen including a screen pointer controllable by a user with a screen pointing device, the method comprising:

providing a first plurality of user selectable scrolling zones on the display screen, each scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a first direction, each of the scrolling zones in the first plurality being positioned substantially adjacent to a first edge of the display screen

providing a second plurality of user selectable scrolling zones on the display screen, each scrolling zone in the second plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a second direction that is different from the first direction, each of the scrolling zones in the second plurality of being positioned substantially adjacent to a second edge of the display screen, wherein the first edge is opposite to the second edge;

receiving zone selection information identifying a first one of the scrolling zones selected by a user with the screen pointing device; and

scrolling through the displayed information based on the scrolling technique associated with the selected scrolling zone.

2.(Original) The method of claim 1, wherein each scrolling technique corresponds to a scrolling speed.

3.(Original) The method of claim 1, wherein each scrolling technique corresponds to a scrolling granularity.

4.(Original) The method of claim 3, wherein the scrolling granularities include line scrolling, paragraph scrolling, and page scrolling.

5.(Cancelled)

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6.(Previously Presented) The method of claim 1, wherein the first plurality of scrolling zones is positioned substantially adjacent to a top of the display screen and corresponds to upward scrolling, and wherein the second plurality of scrolling zones is positioned substantially adjacent to a bottom of the display screen and corresponds to downward scrolling.

7.(Previously Presented) The method of claim 1, wherein the first plurality of scrolling zones is positioned substantially adjacent to a left edge of the display screen and corresponds to leftward scrolling, and wherein the second plurality of scrolling zones is positioned substantially adjacent to a right edge of the display screen and corresponds to rightward scrolling.

8.(Previously Presented) The method of claim 1, and further comprising:
providing a third and a fourth plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a third direction that is different from the first and the second directions, each scrolling zone in the fourth plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a fourth direction that is different from the first, second, and third directions.

9.(Original) The method of claim 1, and further comprising:
displaying a first plurality of zone representations on the display screen representing the first plurality of user selectable scrolling zones.

10.(Original) The method of claim 9, wherein each of the zone representations indicates a scrolling technique.

11.(Original) The method of claim 9, wherein each of the zone representations indicates a boundary of a user selectable scrolling zone.

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12.(Original) The method of claim 1, wherein the scrolling techniques associated with the scrolling zones are user definable.

13.(Previously Presented) The method of claim 1, wherein the first plurality of user selectable scrolling zones are positioned directly adjacent to one another and spread across substantially an entire width of the display screen.

14.(Previously Presented) The method of claim 1, wherein the first plurality of user selectable scrolling zones are spaced apart from each other and spread across substantially an entire width of the display screen.

15.(Previously Presented) The method of claim 1, and further comprising, providing a third plurality of user selectable scrolling zones on the display screen, each scrolling zone in the third plurality of scrolling zones associated with a scrolling technique and corresponding to scrolling in a direction that is different from the first and the second directions, and wherein the first, the second, and the third plurality of user selectable scrolling zones collectively include nine scrolling zones organized into three columns and three rows.

16.(Original) The method of claim 14, and further comprising:

sensing a current position of the screen pointer;

identifying a scrolling zone that is positioned near the current position of the screen pointer; and

automatically positioning the screen pointer over the identified scrolling zone.

17.(Original) The method of claim 1, and further comprising:

providing at least one user selectable action zone on the display screen, the at least one action zone associated with a display modifying action.

18.(Original) The method of claim 17, and further comprising:

varying the display modifying action associated with the at least one action zone based upon the content currently displayed on the display screen.

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19.(Previously Presented) An electronic device comprising:

a display screen for displaying information, the display screen including a screen pointer controllable by a user with a screen pointing device, the display screen including a first plurality of user selectable scrolling zones, each user selectable scrolling zone in the first plurality of scrolling zones associated with a scrolling technique and having a user selectable area defined by hidden boundaries; and

a controller for receiving zone selection information identifying a first one of the scrolling zones selected by a user with the screen pointing device, the controller configured to cause information displayed on the display screen to scroll based on the scrolling technique associated with the selected scrolling zone.

20.(Original) The device of claim 19, wherein each scrolling technique corresponds to a scrolling speed.

21.(Original) The device of claim 19, wherein each scrolling technique corresponds to a scrolling granularity.

22.(Original) The device of claim 21, wherein the scrolling granularities include line scrolling, paragraph scrolling, and page scrolling.

23.(Original) A method of scrolling through information displayed on a display screen of an electronic device, the display screen including a screen pointer controllable by a user with a screen pointing device, the method comprising:

receiving mode selection information from a user, the mode selection information indicating that a user has selected a scroll mode;

receiving movement information provided by a user with the screen pointing device;

determining a first movement direction and a first movement velocity based on the received movement information;

moving the screen pointer based on the received movement information; and

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scrolling the displayed information on the display screen in a direction corresponding to the first movement direction and in an amount based on the first movement velocity, the scrolling amount greater than the amount of movement of the screen pointer.

24.(Previously Presented) The method of claim 1, wherein at least one of the scrolling zones is defined by hidden boundaries that are invisible to a user of the electronic device.